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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/551,252 04/18/00 BRODBECK

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EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

10/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/551,252

Applicant(s)
Brodbeck et al.

Examiner
Clark F. Dexter

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3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 17-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 17-19 and 35, drawn to a cutting apparatus with a specific cutting tool mounting and positioning structure, classified in class 83, subclass 425.4.
 - II. Claims 17, 20 and 21, drawn to a cutting apparatus with a specific ejector configuration, classified in class 83, subclass 111.
 - III. Claims 17 and 22-26, drawn to a cutting apparatus with a specific cutting tool configuration, classified in class 83, subclass 491.
 - IV. Claims 17, 25, 27, 28 and 37, drawn to a cutting apparatus with a recognition switch, classified in class 83, subclass 360.
 - V. Claims 17, 29-34, 36 and 38, drawn to a cutting apparatus with a specific counter-holder configuration, classified in class 83, subclass 451.
2. Claims 17-38 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific cutting tool mounting and positioning structure of Group I). It is noted that if claim 17 as originally filed is determined to be patentable, rejoinder of claims 17-38 will be considered. It is further noted that claim 17 is listed as part of groups I-V but is not considered to be part any of these groups. Rather, claim 17 recites subject matter that is common to all of the groups and has been shown as part of each group for clarity

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(i.e., so that it is clear which claims are part of which group). Further, because claim 17 includes subject matter that is common to all of the groups, it is not considered to be independent or distinct from any of the groups. Therefore, claim 17 will be examined upon election of one of the groups.

3. The inventions are distinct, each from the other because of the following reasons:

Group I vs Groups II-V

4. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the ejector configuration of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the cutting tool mounting and positioning structure of group I for patentability as evidenced by the omission thereof from group II.

5. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the specific details of the cutting tool configuration of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the cutting tool mounting and positioning structure of group I for patentability as evidenced by the omission thereof from group III.

6. Inventions of groups I and IV are separate inventions. They are distinct because the invention of group I does not require the recognition switch of group IV for patentability as evidenced by the omission thereof from group I, and the invention of group IV does not require

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the specific details of the cutting tool mounting and positioning structure of group I for patentability as evidenced by the omission thereof from group IV.

7. Inventions of groups I and V are separate inventions. They are distinct because the invention of group I does not require the specific details of the counter-holder configuration of group V for patentability as evidenced by the omission thereof from group I, and the invention of group V does not require the specific details of the cutting tool mounting and positioning structure of group I for patentability as evidenced by the omission thereof from group V.

Group II vs Groups III-V

8. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the specific details of the cutting tool configuration of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the specific details of the ejector configuration of group II for patentability as evidenced by the omission thereof from group III.

9. Inventions of groups II and IV are separate inventions. They are distinct because the invention of group II does not require the recognition switch of group IV for patentability as evidenced by the omission thereof from group II, and the invention of group IV does not require the specific details of the ejector configuration of group II for patentability as evidenced by the omission thereof from group IV.

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10. Inventions of groups II and V are separate inventions. They are distinct because the invention of group II does not require the specific details of the counter-holder configuration of group V for patentability as evidenced by the omission thereof from group II, and the invention of group V does not require the specific details of the ejector configuration of group II for patentability as evidenced by the omission thereof from group V.

Group III vs Groups IV-V

11. Inventions of groups III and IV are separate inventions. They are distinct because the invention of group III does not require the recognition switch of group IV for patentability as evidenced by the omission thereof from group III, and the invention of group IV does not require the specific details of the cutting tool configuration of group III for patentability as evidenced by the omission thereof from group IV.

12. Inventions of groups III and V are separate inventions. They are distinct because the invention of group III does not require the specific details of the counter-holder configuration of group V for patentability as evidenced by the omission thereof from group III, and the invention of group V does not require the specific details of the cutting tool configuration of group III for patentability as evidenced by the omission thereof from group V.

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Group IV vs Group V

13. Inventions of groups IV and V are separate inventions. They are distinct because the invention of group IV does not require the specific details of the counter-holder configuration of group V for patentability as evidenced by the omission thereof from group IV, and the invention of group V does not require the recognition switch of group IV for patentability as evidenced by the omission thereof from group V.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Species

15. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species IIIA - an undriven cutting tool (Figure 1); and

Species IIIB - a driven cutting tool (Figure 1).

Upon election of Group III, applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 17 is generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
October 15, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.